

the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

...

In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits...Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability...If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration...On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended.

The Office has improperly required restriction between Groups I and II, because these two groups contain claims that are Markush-type claims for which a search and examination can be made without serious burden. The members of Groups I and II differ only in that Group I relates to compounds containing a 5-membered pyrrolidine ring and Group II relates to compounds containing a 6-membered piperidine ring. The members of Groups I and II thus differ only by one carbon atom in their corresponding N-containing rings. Groups I and II are part of one Markush-type claim. The Office should therefore examine the members of Groups I and II on the merits by the procedure explained above, i.e., by a provisional elections of species with an expanded search if the elected species allowable over the prior art.

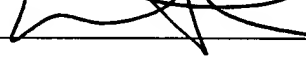
Applicants therefore request that the Office rejoin Groups I and II and consider Groups I and II to form a single group for the purposes of examination. Applicants would elect the resulting combined group and would provisionally elect the species of a composition comprising compound 30, which is encompassed by claim 13.

Alternatively, Applicants request that the Office restructure the groupings to place the compounds of Groups I and II in one group and the corresponding compositions in a second group. Group I would then be the pyrrolidinyl and piperidinyl compounds of claims 1-5 and Group II would be pyrrolidinyl and piperidinyl compositions of claims 8-13. Applicants would then elect Group II to pursue the pyrrolidinyl and pyrrolidinyl compositions of claims 8-13 and would provisionally elect the species of a composition comprising compound 30, which is encompassed by claim 13.

Please charge or credit Deposit Account No. 19-0741 for all fees as needed.

Respectfully submitted,

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